

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

In re Patent Application of:  
Aya JAKOBOVITS et al.

Application No.: 09/771,312

Confirmation No.: 7650

Filed: January 26, 2001

Art Unit: 1642

For: 84P2A9: A PROSTATE AND TESTIS  
SPECIFIC PROTEIN HIGHLY EXPRESSED IN  
PROSTATE CANCER

---

Examiner: B. Fetterolf

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Under MPEP 1205.03, a response to the Notification of Non-Compliant Appeal Brief was due on April 18, 2008, one month after the mailing date of the Notification of Non-Compliant Appeal Brief. With this response, Applicants have submitted a two-month Extension of Time under 1.136, extending the deadline to June 18, 2008. The response is thus timely filed.

Applicants respectfully disagree with the characterization that the Appeal Brief as originally filed does not contain a concise explanation of the claimed subject matter as required by 37 C.F.R. §41.37(c)(1)(v). Reference is made to Sections V.A and V.B of the Appeal Brief, which Applicants content satisfies the requirements of 37 C.F.R. §41.37(c)(1)(v). However, to the extent that the Appeal Brief was considered to be defective due to insufficient references to the specification and

drawings, Applicants herewith submit amendments to Sections V.A and V.B. Therefore, this response should not be considered a petition under 37 C.F.R. §1.181.

Furthermore, as required by MPEP 1205.03, because the Appeal Brief was found to be defective solely because the Appeal Brief allegedly does not contain a concise explanation of the claimed subject matter as required by 37 C.F.R. §41.37(c)(1)(v), Applicants are only submitting amendments to the previously-filed explanation of the claimed subject matter.

**AMENDMENTS TO APPEAL BRIEF**

**Please replace the entirety of section V with the following new section V:**

--V. **SUMMARY OF CLAIMED SUBJECT MATTER**

The subject matter of the pending claims relates to a novel gene and its encoded protein, termed 84P2A9, which are expressed in normal cells and at high levels in cancerous prostate cells. (Specification, page 14, lines 22-26. A summary of the subject matter of the three pending independent claims is as follows. Independent claim 12 recites a protein comprising the amino acid sequence of SEQ ID NO: 2. (Specification, page 116, lines 24-25.)

Independent claim 14 recites a protein having an amino acid sequence encoded by a polynucleotide selected from a group of four alternatives. In the first, the polynucleotide has the sequence of SEQ ID NO: 1, wherein T can also be U. (Specification, page 18, line 29 through page 19, line 2.) In the second, the polynucleotide has the sequence shown in SEQ ID NO: 1, from nucleotide residue number 163 through nucleotide residue number 1674, wherein T can also be U. (Specification, page 19, lines 4-7.) In the third, the polynucleotide encodes a protein whose sequence is encoded by the cDNAs contained in the plasmids designated p84P2A9-1, deposited with the American Type Culture Collection as Accession No. PTA-1151. (Specification, page 19, lines 7-9.) In the fourth, the polynucleotide encodes a protein having the amino acid sequence shown in SEQ ID NO: 2. (Specification, page 117, lines 12-13.)

Independent claim 39 recites a pharmaceutical composition. The composition is comprised of a recombinant protein comprising the amino acid sequence of SEQ ID NO: 2 and a physiologically acceptable carrier. (Specification, page 64, lines 13-20.)--

**CONCLUSION**

If, for any reason, the Examiner still believes the Appeal Brief to be non-compliant, even in view of the new section V provided above, Applicants request that the Examiner contact the undersigned attorney at the Los Angeles telephone number (213) 892-5752 to discuss any steps necessary to place the Appeal Brief in compliance.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Docket No. 511582000100.

Dated: June 18, 2008

Respectfully submitted,

By /Daniel A. Rubé/  
Daniel A. Rubé, Ph.D.  
Registration No.: 53,536  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, California 92130-2040  
(858) 720-7987